

REMARKS

Claims 1, 10, 13, 22, 25, 31, 37, 40, 41, and 44 are amended herein. Claims 1-45 will be pending upon entry of this Amendment.

I. Response to Restriction Requirement

The Office action sets forth a restriction requirement in which the Examiner has grouped the claims of the application into two Groups, designated Group I and Group II. Group I includes claims 1-36 directed to a package for protecting an integrated circuit device and Group II includes claims 37 directed to a process for making a package for protecting an integrated circuit device. Applicant provisionally elects the claims of Group II for examination with traverse.

Reconsideration is respectfully requested of the restriction requirement and, in particular, of the reason stated in the Office action for the restriction requirement. It is stated in the Office action that "the process [of claim 37] can be used to make a materially different product whereby the product can be made without using a laser". However, the process of claim 37, as originally submitted and as amended herein does not recite the use of a laser. The process of claim 37 as amended is as follows:

37. A process for forming a package for protecting an integrated circuit device mounted on a substrate comprising the steps of:

placing a cap in contact with the substrate such that said cap and said substrate form a junction and define an enclosed space for the integrated circuit device; and

applying thermal energy to the junction by **first passing thermal energy through the substrate to heat the junction to form a bond between the cap and the substrate**, said bond providing a near-hermetic seal for the enclosed space.

Claim 41 recites a similar process requiring placing a cap in contact with an integrated circuit device to form a junction and first passing thermal energy through the integrated circuit device to heat the junction to form a bond. Claim 45 recites a similar process requiring passing thermal energy through an

integrated circuit device wafer to heat a grid of fusible material to form a bond between a cap wafer and the integrated circuit device wafer.

The package of amended claim 1 is as follows:

1. A package for protecting an integrated circuit device having an active side, said package comprising:
 - a substrate for mounting the integrated circuit device;
 - a plastic cap mounted on the substrate **to form a junction between the plastic cap and the substrate** and an enclosed space for the active side of the integrated circuit device;
 - a thermal bond formed between the substrate and the plastic cap to effectively seal the enclosed space so as to prevent the ingress of moisture or particulates, **said thermal bond being formed by first passing thermal energy through the substrate to heat the junction.**

Similarly, package claims 13, 25, and 31 also recite a junction between the plastic cap and the substrate (or integrated circuit device) and a thermal bond formed by first passing thermal energy through the substrate (or integrated circuit device) to heat the junction.

There is no way to practice the process of claims 37, 41, and 45 without resulting in a package having a bond between a plastic cap and a substrate (or integrated circuit device) that forms an enclosed space of the package. As such, it is respectfully submitted that claims 1, 13, 25, and 31, directed to a package for protecting an integrated circuit device, and claims 37, 41, and 45, directed to a process for forming a package, are not directed to "distinct inventions" as set forth in MPEP 803.

Additionally, applicant asks the Examiner to consider the relative burdens on himself and the applicant. In order for a reliable search to be conducted for either applicant's product or process claims, both class/subclass combinations will have to be searched. Accordingly, maintaining all claims in the application should not add more than a minimal burden. Further, applicant has minimized any such additional burden by presenting the claims in a manner of parallel product and process claims. In this regard the Examiner is asked to consider MPEP 803 which states

that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions." (emphasis added).

Applicant respectfully submits that the burden of examining parallel product and process claims having overlapping search fields cannot fairly be said to be "serious." In contrast, applicant would incur filing fees of at least \$1000, issue fees of at least \$1400, and maintenance fees of at least \$7000 if required to prosecute and maintain a second application/patent, such fees being in addition to the similar fees to be incurred in this first application.

Applicant further emphasizes that the Office often examines both product and process claims in the same application in situations such as this. Recent analogous patents include the following:

6,822,324

Claim 1. A package comprising. . . .

Claim 10. A method of fabricating a package at wafer level, the method comprising the steps of:. . . .

6,818,980

Claims 1 and 7. An integrated circuit package comprising. .

. . .

Claims 8, 12, and 13 . A process for fabricating an integrated circuit package, comprising. . . .

6,693,364

Claim 1. An optical integrated circuit element package, comprising. . . .

Claim 8. A process for making an optical integrated circuit element package, comprising the following steps. . . .

These are not isolated instances, as the patent collection is replete with such patents. While this is not controlling on the Examiner in the present case, applicant respectfully requests that it be taken into account when weighing the relative burdens, the closely parallel nature of applicant's process and product claims, and the overlapping, if not identical, nature of the respective searches required.

In view of the foregoing, applicant respectfully asks the Examiner to withdraw the restriction requirement.

As required by 37 CFR 1.143, applicant provisionally elects the Group II claims for prosecution (claims 37-45) in the event that the restriction requirement is made final.

II. Conclusion

Favorable consideration and allowance of claims 1-45 is respectfully requested.

A check and fee transmittal are enclosed for payment of the one-month extension of time fee. The Commissioner is authorized to charge any fee deficiency or credit any overpayment to Deposit Account No. 19-1345 in the name of Senniger Powers.

Respectfully submitted,

Andrew N. Claerbout

Andrew N. Claerbout, Reg. No. 50,202
SENNIGER POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

ANC/MEG/jmd

Express Mail No. EV 504797765 US
Mail Stop Amendment